PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number: 02103-0581001	
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number 10/752,391	Filed January 6, 2004
	First Named Inventor William Allen et al.	
Date of Deposit Signature	Art Unit 2612	Examiner Vernal U. Brown
Typed or Printed Name of Person Signing Certificate		

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.
     Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.

6 Total of no. forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Allen et al.   Art Unit   : 2612
Serial No. : 10/752,391   Examiner : Vernal U. Brown
Filed   : January 6, 2004   Conf. No. : 3571
Title   : REMOTE CONTROLLING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>PRE-APPEAL BRIEF REQUEST FOR REVIEW</u>

Please review the rejections of claims 1 and 9. These rejections, based on Allport (6,104,334) and Bernier (20040040039), are wrong, because they rely on the incorrect theory that Allport and Bernier display a current value of a preset and a possible new value of a preset <u>simultaneously</u> and then allow the user to choose the new value. In fact, neither Allport nor Bernier described those concepts.

Claims 1 and 9 both recite features of a control device, such as a remote control for a radio receiver (the breadth of the claims is not limited by those examples, of course).

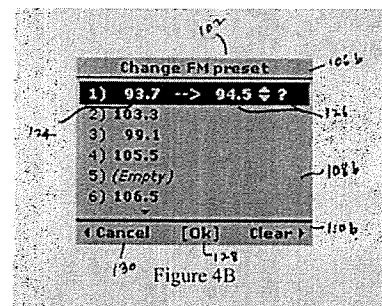Claim 1 relates to presets (for example, radio station presets) on the remote control.

An example of a preset is a button that tunes to a saved radio frequency of a preferred radio station. The user sets the preset to that frequency, ahead of time. By setting several presets ahead of time in this way, a user can later switch easily among preferred stations without having to tune the radio to each of them in a more time-consuming way.

Claim 1 is about how a user can change the preset value (e.g., the frequency) from an old preset value to a new preset value, so that the preset will take the listener to the new preset station and no longer to the old one.

As shown in the example of figure 4B of the application, it is much easier for the user to comprehend the available options if <u>both</u> the current value 124 of the preset (e.g., 93.7 MHz) and a proposed new value 126 for the preset (e.g., 94.5MHz) are displayed to her <u>simultaneously</u>.

Figure 4B

In some examples, the current preset value and the possible new preset value are frequencies of stations that are <u>both</u> associated with the <u>same</u> sound signal source—in this case, the radio receiver. The values are <u>not</u> associated with different sound signal sources (such as a radio and a television).

This concept is recited broadly in claim 1 (which has been annotated below in brackets to illustrate an example that ties to figure 4B):

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> *1.   A method comprising*
> *providing, to a user of a control device [the remote control] having a*
> *display [102 on the remote], a graphical item [numbers] representative of an*
> *indication of a value [the frequency of a radio station] representative of a current*
> *preset [item 124] associated with a sound signal source [the radio],*
> *simultaneously providing on said display a graphical item that is an*
> *indication of a value [item 126] of a possible new preset associated with the*
> *sound signal source [the radio], and*
> *providing the user an edit option [item 128] allowing the user to change*
> *the current value to the new value.*

Claim 1 should not have been rejected based on Allport, because Allport's system does not simultaneously display both a current preset and a possible new preset and does not allow the user to change the current value of a preset to a new value of the preset for a given signal sound source.

What Allport's system does allow a user to do is to <u>make a list</u> of "favorite alternatives," which could be considered a list of presets. Items can be <u>added</u> to or <u>removed</u> from the list of favorite alternatives.

But what is shown to the user and the way in which the user can change the list in Allport have nothing to do with what is recited in claim 1. Strikingly, there is almost nothing in claim 1 that is in Allport.

Take the parts of Allport that the examiner relied on, figures 5 and 7 and related text:

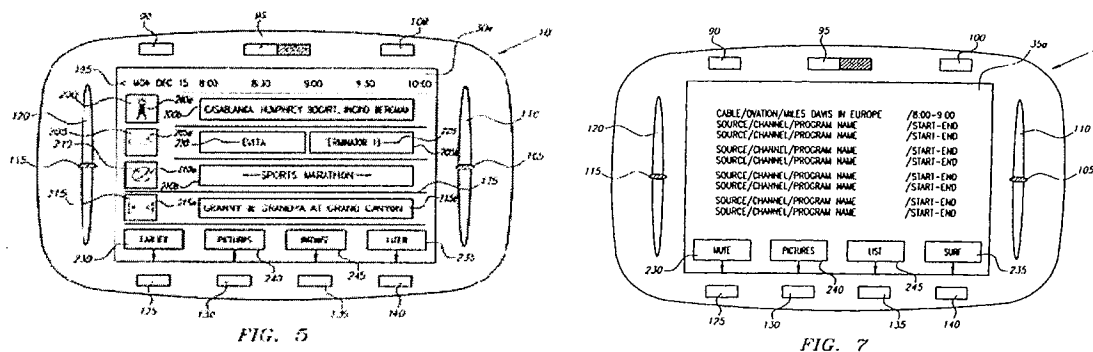FIG. 5   FIG. 7

Figure 5 shows display areas representing programs that can be watched right now, such as Casablanca, Evita, and Terminator. Yet none of these is a preset value. And no two of the programs shown in figure 5 relate to each other as a current value relates to a future value of a preset.

Preset values, to the extent they might be found in Allport, are displayed instead on the favorites list of figure 7, not on figure 5.

What the user can do on figure 5 is limited. She can mark an individual item to be <u>added</u> to or <u>removed</u> from a separate favorites list (which is not displayed on figure 5) in this way:

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If the consumer touches an area displaying a particular program (e.g., area 220), that program (i.e., Evita) will be tagged and added to the list of favorite selections and can then later be listed and browsed from the "browse favorite alternatives" screen 35a. If the program was already in the list, it would be removed therefrom. Programs that are already in the favorites list are highlighted in some manner (e.g., bold, italics, underline, or capital letters), so that touching the associated area would highlight or un-highlight the program and correspondingly add or remove the program from the list. [col. 14, ln. 7-17]

Adding and removing a program from a favorites list has nothing to do with changing the value of a particular preset from a current value to a new value while both values are being displayed.

Figure 7, on the other hand, is used for <u>browsing</u> the favorites, <u>not for changing</u> them:

The display 85 here shows the list of programs selected by the consumer from the "list alternatives" screen 30a as previously described. ... Programmable button 140 ... causes the display of the controlled device to cycle through all of the favorite selections, pausing on each selection for a predetermined amount of time ... Slider 105 changes programs between selected favorites, and does not require explicit selection of the source device because the scheduled data that is downloaded has already been associated with the proper IR commands. [col. 15, ln. 63- col. 16, ln. 16]

The examiner's interpretation, that icons 205a, 210a, and 215 of Allport's figure 5 simultaneously display graphical items that represent the current and new values of a preset, is wrong.

The icons 205a, 210a, and 215 respectively "indicate the <u>source</u> of the listed programs, while corresponding areas 200b, 205b, 210b, and 215b indicate the actual programs being considered by the consumer ..." (Allport, col. 13, ln. 49-53, emphasis added). Icons 205a, 210a, and 215 have nothing to do with enabling a user to change the value of a preset. In fact, those icons represent different <u>sources,</u> <u>not</u> current and possible new values of presets associated with a single source. And no two of those icons represent current and new values of a preset of any source.

The examiner cites column 14, at line 7, as having described a way to change the current value of a preset to a new value. But that passage describes only adding or removing a favorite from a list of favorites and <u>not</u> enabling the user to change the value of one of the favorites.

The examiner contends that "the current preset and the possible new values represent TV channels numbers and are therefore associated." But—whatever that means and whether it is true or not—Allport did not describe and would not have made obvious <u>providing the user a way to change the current value of a preset to a new value, let alone doing that by providing simultaneously on a display two graphical items that are respectively representative of a current value of a preset associated with a source and a new value of a preset associated with the source.</u>

We turn to claim 9, which refers to a different feature, also illustrated by figure 4B in the form of the up and down arrows to the right of the new value of the preset. The up and down arrows permit the user to change the new value for the preset. The radio then plays the new value for the preset that has been chosen by the user. Once the user has found a good station, she can commit the preset to the newly-chosen value.
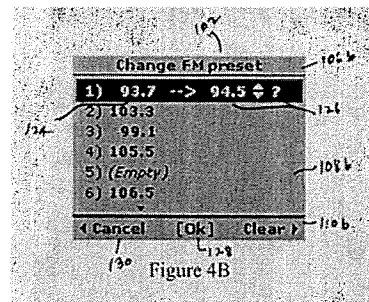
The patent application explains this feature in paragraphs 41-43:

> While a station is highlighted, the user may enter (and may change) a new value 126 for the preset. Both the current preset 124 and the new value 126 are shown on display 52 at the same time. <u>To enter a new value for the highlighted preset</u>, the user presses the center button 58 up or down to tune up or down, …

> … The proposed change is not stored until the user invokes the "Ok" option in the navigation bar by pressing the enter button 58. Until that happens, he is able to continue to change the proposed new station value. He may also press the right arrow button 54 to completely clear a preset, marking it as (Empty).

> … <u>To change the preset from the current preset frequency 124 to the new preset frequency 126 the user selects Ok</u> 128 from the navigation bar 110b by pressing the enter button 58 on the remote device 50 … [emphasis added]

This concept is recited broadly in claim 9:

> 9. *A method comprising*
>   *enabling a user of a control device*
>   *to indicate a value of a possible new preset of a sound signal source and*
>   *to separately confirm the indication, and,*
>   *while the new value has been indicated and before the indication has been confirmed, to change an operation of another device in accordance with the indicated possible new value.*

In rejecting claim 9 based on Bernier, the examiner argued:

The operation of the second device (TV) is change[d] before confirming the new value of the sound source because the display of the TV is change[d] to indicate the possible new favorite channel (paragraph 088).

The applicant respectfully disagrees. The fact that the operation of Bernier's TV may have changed because it displays the identity of another favorite channel to which the user has scrolled is irrelevant. Claim 9 requires that the new value to which the final clause refers be a <u>possible new value of a preset</u> of a sound signal source.

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The applicant does not dispute that the user in Bernier can add channels to a favorites list or delete channels from the favorites list, as described below:

> To add the Disney channel 316 to the list of favorite channels in Dabney's cartoon favorites, the user preferably selects the favorites button 492 for a sustained duration. In response, the DABFAV symbol 1970 preferably appears in the display channel area 1980 of the IPG screen 1900 in proximity to the selected Disney channel 316, thus providing feedback to the user that the selected channel is now added to Dabney's cartoon favorites. To add additional favorite channels while in the display favorites mode, the user preferably scrolls to non-favorite channels using the navigation arrow keys 485 (FIG. 4), and then presses the favorites button 492 for a sustained duration for the highlighted selection. [paragraph 74, emphasis added]
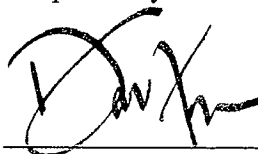
But Bernier said nothing about changing an operation of the TV in accordance with a possible new value of a preset of a sound signal source before the selection has been confirmed. Rather, in Bernier, the operation of the TV is changed merely as a confirmation that the new value of a preset has been added to the favorite list.

Dependent claims 2-3, 6-8, and 10-12 are patentable for at least the same reasons as the claims on which they depend are patentable.

The appeal fee in the amount of $510.00 is being paid using the electronic filing system by way of deposit account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket 02103-0581001.

Respectfully submitted,

Date:_____

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